



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/296 031	04/21/1999	SUSAN A. LYONS PH.D.	D6218	7876

962<sup>d</sup> 7590 10/30/2002

MORGAN LEWIS & BOCKIUS LLP  
1111 PENNSYLVANIA AVENUE NW  
WASHINGTON, DC 20004

EXAMINER

CHEN, SHIN LIN

ART UNIT	PAPER NUMBER
1632	

DATE MAILED: 10/30/2002

*JW*

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No. 09/296,031	Applicant(s) Lyons et al.
Examiner Shin-Lin Chen	Art Unit 1632



— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on Aug 15, 2002

2a)  This action is FINAL. 2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle* 1035 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 32-49 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 32-49 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1)  Notice of References Cited (PTO-892) 4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

2)  Notice of Draftsperson's Patent Drawing Review (PTO-948) 5)  Notice of Informal Patent Application (PTO-152)

3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6)  Other: \_\_\_\_\_

Art Unit: 1633

### **DETAILED ACTION**

Applicants' amendment filed 8-15-02 has been entered. Claim 33 has been amended.

Claims 32-49 are pending and under consideration.

#### *Priority*

Applicants claimed priorities to Application No. 08/774,154 and 60/009,293 while filing continued prosecution application (CPA) request on 4-15-02. The priorities are not granted because **applicants are required to file petition to the commissioner to claim priorities to Application No. 08/774,154 and 60/009,293** while filing CPA that abandons previous application, see 37 CFR 1.181-1.183. Thus, the effective filing date of the present application is the actual filing date of the present application, i.e. 4-21-99. Any inquiry regarding petition, please contact Brian Hearn at (703) 305-1820.

#### *Specification*

1. The priority paper filed 4-15-02 amending the specification by inserting before the first line "This application is a continued prosecution application...which is a continuation-in-part of US Application 08/774,154...60/009,293...all of which are hereby **incorporated by reference in their entirety**" is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material is not supported by the original disclosure

Art Unit: 1633

because the oath/declaration does not claim priority of any application. Thus, the amendment filed 4-15-02 introduce new matter into the specification.

Applicant is required to cancel the new matter in the reply to this Official Action.

***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 32-42 remain rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3-9 of U.S. Patent No. 5,905,027. Although the conflicting claims are not identical, they are not patentably distinct from each other because, although drawn to different scope, they encompass the same invention and obvious variants thereof and is repeated for the reasons set forth in the preceding Official action mailed 5-16-02 (Paper No. 18). Applicants request holding of this rejection until the pending claims are free of prior art.

Art Unit: 1633

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 32-49 remain rejected under 35 U.S.C. 102(e) as anticipated by Ullrich et al., US Patent No. 5,905,027 (A) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ullrich et al., US Patent No. 5,905,027 (A) and is repeated for the reasons set forth in the preceding Official action mailed 5-16-02 (Paper No. 18). Applicant's arguments filed 8-15-02 have been fully considered but they are not persuasive.

Art Unit: 1633

Applicants argue that the present application has claimed priorities to 08/774,154 and 60/009,293 (amendment, p. 4). This is not found persuasive because of the reasons of record and the reasons set forth under section “Priority”.

7. Claims 32-35 and 37-44 remain rejected under 35 U.S.C. 102(b) as being anticipated by Sontheimer et al., 1997 (N) and is repeated for the reasons set forth in the preceding Official action mailed 5-16-02 (Paper No. 18). Applicant's arguments filed 8-15-02 have been fully considered but they are not persuasive.

Applicants argue that the present application has claimed priorities to 08/774,154 and 60/009,293 (amendment, p. 4-5). This is not found persuasive because of the reasons of record and the reasons set forth under section “Priority”.

8. Claims 32-38 and 40-49 remain rejected under 35 U.S.C. 102(a) as being anticipated by Soroceanu et al., 1998 (Cancer Research, Vol. 58, No. 21, p. 4871-4879) and is repeated for the reasons set forth in the preceding Official action mailed 5-16-02 (Paper No. 18). Applicant's arguments filed 8-15-02 have been fully considered but they are not persuasive.

Applicants argue that the present application has claimed priorities to 08/774,154 and 60/009,293 (amendment, p. 5). This is not found persuasive because of the reasons of record and the reasons set forth under section “Priority”.

Art Unit: 1633

*Conclusion*

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shin-Lin Chen whose telephone number is (703) 305-1678. The examiner can normally be reached on Monday to Friday from 9 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds can be reached on (703) 305-4051. The fax phone number for this group is (703) 308-4242.

Questions of formal matters can be directed to the patent analyst, Patsy Zimmerman, whose telephone number is (703) 305-2758.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-0196.

Shin-Lin Chen, Ph.D.

A handwritten signature in black ink, appearing to read "SL Chen".